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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/702,093	10/30/2000	Alison Salyer Bagwell	15260	7880
23556	7590	04/08/2004	EXAMINER	
KIMBERLY-CLARK WORLDWIDE, INC.			REDDICK, MARIE L	
401 NORTH LAKE STREET			ART UNIT	
NEENAH, WI 54956			PAPER NUMBER	

1713

DATE MAILED: 04/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/702,093

Applicant(s)

BAGWELL ET AL.

Examiner

Judy M. Reddick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11, 12 and 14-53 is/are pending in the application.
- 4a) Of the above claim(s) 14-53 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-7 is/are allowed.
- 6) ☒ Claim(s) 8, 9, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

**Response to Amendment**

1. The amendment to the claims filed on 01/20/40 is acknowledged and has been carefully considered. The indication of allowability of claims 11 & 12 over the prior art of record per the previous Office Action(12/03/03, paragraph no. 8) is herein regrettably rescinded based on the newly discovered prior art. A rejection, based on said prior art, is deemed proper and is as set forth infra. The Response, however, does not address "the use of trademarks" issue raised in the previous Office Action(12/03/03).

**Claim Rejections - 35 USC § 112**

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 8 & 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "further comprising an additive" per claim 8 constitutes indefinite subject matter as per it not being readily ascertainable as to how the broader terminology "comprising" further limits the antecedently recited narrower terminology "consisting essentially of".

**Claim Rejections - 35 USC § 102**

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lagasse et al(U.S. 4,240,918).

Lagasse et al disclose and exemplify aqueous washing bath compositions(solutions) defined, basically, as containing a detergent composition derived from i) an anti-soiling and anti-redeposition amount of at least one polymer A, ii) at least one solubilizing or dispersing agent B which includes urea(comfortably meeting component b) per claims 11 & 12), iii) at least one water repellent C and iv) a detergent builder which includes carbonates such as sodium carbonate(comfortably meeting component a) per claims 11 & 12) and v) other conventional additives wherein, the content of solubilizing or dispersing agent B, expressed as a weight ratio, is at least 0.5 and the content of detergent builder is 10 to 60% by weight(the Abstract, col. 1, lines 7-13 & 58-68, col. 2, lines 4-29, col. 4, lines 38-68, col. 5, lines 15-20, col. 6, lines 1-41 & 66-68, col. 7, lines 1-2, col. 8, lines 57-65, col. 9, lines 15-46, col. 13, TABLE I, col. 18, TABLE IX and the claims, especially claims 7 and 23-30). Lagasse et al therefore anticipate the instantly claimed invention with the understanding that the aqueous washing bath compositions of Lagasse et al overlap in scope with the claimed aqueous composition, in both content and character and with the understanding that the "consisting essentially of clause" limits the scope of a claim to the specified ingredients and those that do not materially affect the basic and novel characteristics of a composition(Ex parte David, 80 USPQ 448; In re Janakirama-Rao, 317 F2d 951, 137 USPQ 893).

It would be expected that the aqueous compositions of Lagasse et al would qualify as an imbibitor and have utility for enhancing image visualization and retention of reactive dye-based inks since the aqueous composition of Lagasse et al is essentially the same as and made under essentially the same conditions as the claimed aqueous composition. It has been held that where applicants claim a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594. "The absence of a disclosure relating to function does not defeat a finding of anticipation. It is well settled that the recitation of a new intended use for an old product does not make a claim to that old product". *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed Cir 1997). The discovery of a new property or use of a previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to a known composition. *In re Spada* 15 USPQ 2d 1655 (CAFC 1990).

Even if it turns out that the instantly claimed invention is not anticipated over the disclosure of Lagasse et al, it would have been obvious to the skilled artisan to extrapolate, from the disclosure of Lagasse et al, the precisely defined aqueous solution, as per such having been within the purview of the general disclosure of Lagasse et al and with a reasonable expectation of success.

#### Election/Restrictions

7. Claims 14-53 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention.

#### Allowable Subject Matter

8. Claims 1-9 are deemed allowable over the prior art of record as per said art neither anticipating nor rendering obvious the precisely defined aqueous coating formulation containing a) a cationic homo- or copolymer, b) a cationic or non-ionic fabric softener, c) urea and d) an ingredient selected from the group consisting of sodium bicarbonate, sodium carbonate and combinations thereof (claim 1). One having ordinary skill in the art would not have been endowed with any motivation to extrapolate the precisely defined aqueous coating formulation, as claimed, from any of the prior art of record with any reasonable expectation of success. Moreover, too much picking and choosing would have been involved and highly unwarranted.

#### Specification

9. The use of the at least trademarks Varisoft 222, Adogen 432, Accosoft 550, Alubrasoft Super 100 and 116, Ahcovel Base N-62 per at least Runs 1, 3, 6, 7, 10, 13, 14-16, 21, etc. have been noted in this application. They should be capitalized wherever they appear and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner, which might adversely affect their validity as trademarks.

#### Conclusion

10. The additional prior art listed on the attached FORM PTO 892 is cited as of being illustrative of the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Judy M. Reddick*  
Judy M. Reddick  
Primary Examiner  
Art Unit 1713

JMR *JMR*  
04/04/04